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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,660	08/24/2000	Jesus Mena	L9406-002	3538

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EXAMINER	
LEE, PHILIP C	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/645,660	MENA, JESUS	
	Examiner	Art Unit	
	Philip C Lee	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *4* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This action is responsive to the amendment and remarks filed on May 14, 2004.

2. Claims 1-3 and 5-20 are presented for examination.

3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3, 5-8, 12-14, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lazarus et al, U.S. Patent 6,134,532 (hereinafter Lazarus).

7. As per claim 1, Lazarus taught the invention as claimed comprising:

one or more subscriber servers for collecting information identifying a user and providing a first data set of user information (col. 17, lines 5-23; col. 21, lines 15-col. 22, lines 13);

one or more demographic databases having third party information and providing a second data set (col. 18, lines 53-col. 19, lines 23; col. 20, lines 30-43); and

a processor in operative communication with the one or more subscriber servers and the one or more demographic databases and receiving said first data set from the one or more subscriber servers (col. 17, lines 5-11) and said second data set from the one or more demographic databases (col. 22, lines 45-64), said processor including a rule processor (col. 15, lines 59-61; col. 16, lines 39-41) receiving said first data set and said second data set and applying said first and second data sets to one or more rules to determine a score predicting behavior relating to said collected information identifying said user (col. 22, lines 45-64). (It is inherent that Lazarus's system with modules performing the claimed invention could include one or more subscriber servers and a processor.)

8. As per claim 2, Lazarus taught the invention as claimed in claim 1 above. Lazarus further taught wherein the processor receives the first data set of user information from one of

the subscriber servers and generates a unique key corresponding to the collected information identifying a user (col. 19, lines 39-58).

9. As per claim 3, Lazarus taught the invention as claimed in claim 2 above. Lazarus further taught wherein the one or more subscriber servers communicate to the processor said first data set of user information about the user based on information identifying the user (col. 16, lines 58-col. 17, lines 3).

10. As per claim 5, Lazarus taught the invention as claimed in claim 1 above. Lazarus further taught wherein the processor communicates the score to the one or more subscriber servers (col. 22, lines 45-64).

11. As per claims 6 and 7, Lazarus taught the invention as claimed in claim 5 above. Lazarus further taught wherein the one or more subscriber servers use the score communicated by the processor to selectively market products and services to the user (col. 22, lines 45-64).

12. As per claim 8, Lazarus taught the invention as claimed in claim 2 above. Lazarus further taught wherein the unique key corresponds to values indexed by the one or more demographic databases (col. 16, lines 60-62; col. 19, lines 49-53).

13. As per claim 12, Lazarus taught the invention as claimed in claim 8 above. Lazarus further taught wherein the unique key comprises a TCP/IP address (col. 19, lines 40-43).

14. As per claim 13, Lazarus taught the invention as claimed in claim 1 above. Lazarus further taught wherein

the one or more subscriber servers are coupled to an Internet;

the one or more demographic databases are coupled to the Internet; and

the processor is coupled to the Internet (fig. 2A and 2B; col. 7, lines 28-49).

15. As per claim 14, Lazarus taught the invention as claimed comprising the steps of:

receiving from one or more subscriber servers user-identifying indicia and providing a first data set of user information (col. 17, lines 5-23; col. 21, lines 15-col. 22, lines 13);

generating from the user-identifying indicia a key which corresponds to values indexed by one or more demographic databases having third party information (col. 16, lines 60-62; col. 19, lines 49-53; col. 18, lines 53-col. 19, lines 23; col. 20, lines 30-43);

communicating the key to the one or more demographic databases (col. 16, lines 60-62; col. 19, lines 49-53; col. 18, lines 53-col. 19, lines 23; col. 20, lines 30-43);

receiving from the one or more demographic databases demographic information relating to the user-identifying indicia and providing a second data set (col. 16, lines 60-62; col. 19, lines 49-53; col. 18, lines 53-col. 19, lines 23; col. 20, lines 30-43);

applying said first and second data sets to one or more rules to determine a score predicting behavior relating to the user-identifying indicia (col. 22, lines 45-64); and

communicating the predictive score to the one or more subscriber servers (col. 22, lines 45-64).

16. As per claim 18 and 20, Lazarus taught the invention as claimed in claims 1 and 14 above. Lazarus further taught wherein the score is determined using a neural network (col. 20, lines 43-45).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarus.

19. As per claims 17 and 19, Lazarus taught the invention as claimed in claims 1 and 14 above. Lazarus did not specifically detailing the score indicating a likelihood that the user will make a purchase. However, Lazarus taught determining a score to select an advertisement based

on the user's propensity to make a purchase (col. 19, lines 9-15; col. 22, lines 52-57; col. 25, lines 8-15).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a score for the indication of a likelihood that the user will make a purchase because by doing so would allow increase the alertness of seller by targeting potential user based on the score.

21. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarus in view of Kappel, U.S. Patent 6,144,988 (hereinafter Kappel).

22. Kappel was cited in the last office action.

23. As per claim 9-11, Lazarus did not specifically detail the unique key. Kappel taught that the unique key could be the type of information that can be standardized according to certain specifications (col. 7, lines 5-14).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Lazarus and Kappel because Kappel's teaching of information that can be standardized according to certain specifications such as an email address, a postal address, or a Social Security Number as the unique key would enhance the field of use in Lazarus's system.

25. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarus in view of Gerace, U.S. Patent 5,848,396 (hereinafter Gerace).

26. Gerace was cited in the last office action.

27. As per claims 15 and 16, Lazarus taught the invention as claimed in claim 14 above. Lazarus did not specifically detail type of applications based on the score. Gerace taught the step of the subscriber server determining whether or not to offer a user a product based on the score (abstract; col. 2, lines 46-53).

28. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lazarus and Gerace because Gerace's system of determining whether or not to offer a user a product based on the score would increase the likelihood of selling a product in Lararus's system by targeting users with score indicating a tendency to purchase similar product.

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications form the examiner should be directed to Philip Lee whose telephone number is (703) 305-7721.

32. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Philip Lee